

## REMARKS

### I. Summary of the Office Action

Claims 8, 9, 11, and 38-82 are pending.

Claims 8, 9, 11, 38-41, 44-47, 50-53, 56-59, and 62-82 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sitnik U.S. Patent No. 6,160,570 (hereinafter "Sitnik"), Alexander et al. U.S. Patent No. 6,177,931 (hereinafter "Alexander") and Wachob U.S. Patent No. 5,155,591 (hereinafter "Wachob") in view of Herz et al. U.S. Patent No. 6,020,883 (hereinafter "Herz").

Claims 42, 43, 48, 49, 54, 55, 60, and 61 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sitnik, Alexander, Wachob, and Herz in view of Ivanyi U.S. Patent No. 6,286,140 (hereinafter "Ivanyi").

These rejections are respectfully traversed.

### II. Summary of Applicants' Reply

Claims 8, 11, 40, 41, 47, 53, 59, 65, 69, 73, 77, 78, 79, 80, 81, and 82 have been amended to more particularly define the invention. No new subject matter has been added and the amendments are fully supported and justified by the application.

The Examiner's rejections are respectfully traversed.

III.        Applicants' Reply To The  
Rejection of Claims 8 and 42-64

The Examiner rejected independent claims 8, 47, 53, and 59 under 35 U.S.C. § 103(a) as being unpatentable over Sitnik, Alexander, and Wachob in view of Herz. This rejection is respectfully traversed.

Amended independent claims 8, 47, 53, and 59 are directed towards interactive television program guide systems and methods for demographically-targeting advertisements to a given user of an interactive television program guide. Advertisements having associated demographic category data for the interactive television program guide are received. User input is received from the user interface. User values for demographic categories are determined using the user input, where weight values indicative of the user input's effect on the user values are applied to the user inputs.

As shown, for example, in FIG. 3 and described on page 13, lines 6-27 of applicants' specification, user inputs that are received have predetermined weight values associated with them. Different types of user inputs (e.g., watching, recording, setting a reminder, etc.) may each have different effects on the user values. These

differences are reflected by "applying predetermined weight values to the user input." The predetermined weight values are indicative of the effect the corresponding user inputs have on the values of the demographic categories. The greater the weight value of a user input, the greater the effect on the values of the demographic categories associated with such user input.

The user values for demographic categories are stored and compared with the demographic category data associated with the advertisements to determine which advertisements should be displayed by the interactive television program guide for the given user. Based on the comparison, demographically-targeted advertisements for the given user are displayed in the interactive television program guide.

The Examiner correctly acknowledges the novelty of applicants' approaches over the combination of Alexander, Wachob, and Sitnik. Nevertheless, the Examiner contends that this deficiency can be made up with Herz. In particular, the Examiner attempts to draw an analogy between applicants' weight values and the "weights" described in Herz. However, applicants respectfully submit that applicants' predetermined weight values, which are

applied to the user inputs, and Herz's "weight" are in no way similar.

Herz, in contrast, refers to creating virtual channels for satisfying customer preferences. The Herz system estimates a customer profile that is "a collection of mathematical values representing the weighted significance of several predetermined characteristics of the video programming" (Herz, column 10, lines 12-16). Every time a customer picks a program which differs from the program that is predicted based on the current estimated agreement scalars, corrections are made to the estimated characteristic and weight profiles (see Herz, column 32, lines 3-8). The correction is made by calculating a parameter ( $\Delta$ ) and using it to estimate a new customer profile. Thus, the parameter ( $\Delta$ ) or weight of Herz is not applied to the user inputs. Rather, Herz's weight is an output that results from the user input -- i.e., when the customer picks a program that differs from the predicted program. More importantly, predetermined weights values would not be applied to the user inputs because Herz states that the customer's weight of a given characteristic is only adjusted to a new weighting when a predicted program is not selected by the customer (see Herz, column 7, lines 20-34).

Furthermore, even if all of applicants' claimed features were taught by the combination of Sitnik, Alexander, Wachob, and Herz, applicants respectfully submit that the § 103 rejection must be withdrawn for another independent reason. The Office Action failed to provide sufficient motivation for combining the references to justify the assertion of a § 103 rejection. In re Rouffet, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"); see also MPEP § 2142 and 2143.01. It is well-settled that an Office Action can "satisfy this burden only by showing some objective teaching . . . that would lead [one of ordinary skill in the art] to combine the relevant teachings of the references." In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

The Office Action, instead of providing objective evidence of a motivation to make such a combination, merely relies on various conclusions of obviousness that simply states the benefits of applicants' invention

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Sitnik by using weight values to further customize the value of the user to the actual user

(Office Action, page 4). Such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In addition, relying solely on "applicants' disclosure as a blueprint for piecing together the prior art to defeat patentability" is insufficient as a matter of law. In re Kotzab, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 174 F.3d 994, 999 (Fed. Cir. 1999); see also In re Lee, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) ("The factual inquiry of whether to combine references must be thorough and searching"); MPEP § 2143.

Accordingly, for at least these reasons, applicants respectfully request that the rejection of claims 8, 47, 53, and 59 under 35 U.S.C. § 103(a) be withdrawn.

Claims 42-46 are dependent from claim 8 and are allowable at least because claim 8 is allowable. Claims 48-52 are dependent from claim 47 and are allowable at least because claim 47 is allowable. Claims 54-58 are dependent from claim 53 and are allowable at least because claim 53 is allowable. Claims 60-64 are dependent from claim 59 and are allowable at least because claim 59 is allowable.

IV.            Applicants' Response To The Rejection of  
Claims 9, 11, 38, 39, 41, 65-76, and 80-82

The Examiner rejected independent claims 11, 41, 65, 69, 73, and 80-82 under 35 U.S.C. § 103(a) as being unpatentable over Sitnik, Alexander, and Wachob in view of Herz. The Examiner's rejection is respectfully traversed.

Applicants' independent claims 11, 41, 65, 69, 73, and 80-82 are directed towards interactive television program guide systems and methods for demographically-targeting advertisements to a given user of an interactive television program guide. Advertisements having associated demographic category data for the interactive television program guide are received. User demographic information is gathered using a survey (claims 11, 65, 69, and 73) or user input is received from the user interface and used to determine user values for demographic categories (claims 41, 59, and 80-82).

The user demographic information or the user values for demographic categories is stored and compared with the demographic category data associated with the advertisements to determine which advertisements should be displayed by the interactive television program guide for the given user. Based on the comparison, demographically-

targeted advertisements for the given user are displayed in the interactive television program guide.

Common to applicants' claims 11, 41, 65, 69, 73, and 80-82 is applicants' feature of "applying a decay function to each of the" user values in order to refresh the user values. Because it is preferable to target advertisements to users based on current user information, a decay function is used to refresh the values of the demographic categories for the user on a periodic basis, such as every seven days, or based on a specified number of user inputs (see Applicant's specification, page 16, lines 18-23).

The Examiner correctly acknowledges the novelty of applicants' approaches over the combination of Alexander, Wachob, and Sitnik. Nevertheless, the Examiner contends that this deficiency can be made up with Herz. Herz, however, discloses a very different type of approach. Herz does not apply the decay function to each of the user values, such as the "stored user demographic information" (claims 11, 65, 69, and 73) or the "user values for the demographic categories" (claims 41, 80, 81, and 82) to refresh the user values. Instead, "[a]ny dramatic changes will be damped down, especially at later iterations" so that the "customer's profile should stabilize over time"



(Herz, column 15, lines 6-9). By dampening or minimizing the importance of user inputs at later iterations, Herz seeks to achieve a stable user profile. In contrast to Herz, applicants apply a decay function to refresh each of the user values, thereby increasing the importance of current user inputs to determine user values for demographic categories.

Furthermore, even if all of applicants' claimed features were taught by the combination of Sitnik, Alexander, Wachob, and Herz, applicants respectfully submit that the § 103 rejection must be withdrawn for another independent reason. The Office Action failed to provide sufficient motivation for combining the references to justify the assertion of a § 103 rejection. In re Rouffet, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"); see also MPEP § 2142 and 2143.01. It is well-settled that an Office Action can "satisfy this burden only by showing some objective teaching . . . that would lead [one of ordinary skill in the art] to combine the relevant teachings of the references." In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

The Office Action, instead of providing objective evidence of a motivation to make such a combination, merely relies on various conclusions of obviousness that simply states the benefits of applicants' invention

It would have been obvious to one having ordinary skill in the art to dynamically adjust the user values over a given period of time to customize the advertisements accordingly in order to provide current up to date demographic data

(Office Action, pages 5-6). Such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In addition, relying solely on "applicants' disclosure as a blueprint for piecing together the prior art to defeat patentability" is insufficient as a matter of law. In re Kotzab, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 174 F.3d 994, 999 (Fed. Cir. 1999); see also In re Lee, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) ("The factual inquiry of whether to combine references must be thorough and searching"); MPEP § 2143.

Accordingly, for at least these reasons, applicants respectfully request that the rejection of claims 11, 41, 65, 69, 73, and 80-82 under 35 U.S.C. § 103(a) be withdrawn.

Claims 9, 38, and 39 are dependent from claim 11 and are allowable at least because claim 11 is allowable.

Claims 66-68 are dependent from claim 65 and are allowable at least because claim 65 is allowable. Claims 70-72 are dependent from claim 69 and are allowable at least because claim 69 is allowable. Claims 74-76 are dependent from claim 73 and are allowable at least because claim 73 is allowable.

V.            Applicants' Response To The  
Rejection of Claims 40, 77, 78, and 79

The Examiner rejected independent claims 40, 77, 78, and 79 under 35 U.S.C. § 103(a) as being unpatentable over Sitnik, Alexander, and Wachob in view of Herz. The Examiner's rejection is respectfully traversed.

Applicants' amended independent claims 40, 77, 78, and 79 are directed towards interactive television program guide systems and methods for demographically-targeting advertisements to a given user of an interactive television program guide. Advertisements having associated demographic category data for the interactive television program guide are received. User input is received from the user interface. User values for demographic categories are determined using the user input.

A separate period is used for each demographic category, where the period for each category is representative of how much user input is needed before the

user value for that category is deemed to be reflective of the given user. As described in applicants' specification at, for example, page 14, lines 25-30, "[e]ach demographic category may have a period (P), which is the minimum number of user inputs necessary before the demographic category value is deemed to be meaningful and reflective of the user."

These user values are stored and compared with the corresponding demographic category data associated with the received advertisements to determine which advertisements should be displayed by the interactive television program guide. The demographically-targeted advertisements are displayed in the interactive program guide based on the comparison.

The Examiner correctly acknowledges the novelty of applicants' approaches over the combination of Alexander, Wachob, and Sitnik. Nevertheless, the Examiner contends that this deficiency can be made up with Herz.

The Examiner contends that Herz teaches applicants' claimed feature because Herz uses "a period of time to calculate and permit the profiles to stabilize in order to start predictions" and that "at least 3 runs" are needed "before the profiles are good enough to make constant predictions" (Office Action at page 3, emphasis

added). Applicants respectfully submit that Herz has nothing to do with having a period that is representative of how much user input is needed before the user value for that category is deemed to be reflective of the given user. In fact, although estimated profiles are good enough to make constant predictions after three runs, Herz clearly discloses that the predictions made in all three runs (Herz, column 32, line 45 to column 33, line 6), including the first run which uses a user profile that is "initially estimated," are used (Herz at col. 31, line 64; col. 32, line 47). Thus, unlike applicants' approach in which user values are used in comparisons when they are deemed to be reflective of the user as defined by the period, the Herz system only allows the system to predict user profiles regardless of whether the user input is deemed to be reflective of the given user. For at least this reason, applicant respectfully requests that the rejection of claims 40, 77, 78, and 79 under 35 U.S.C. § 103(a) be withdrawn.

Furthermore, even if all of applicants' claimed features were taught by the combination of Sitnik, Alexander, Wachob, and Herz, applicants respectfully submit that the § 103 rejection must be withdrawn for another independent reason. The Office Action failed to provide

sufficient motivation for combining the references to justify the assertion of a § 103 rejection. In re Rouffet, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"); see also MPEP § 2142 and 2143.01. It is well-settled that an Office Action can "satisfy this burden only by showing some objective teaching . . . that would lead [one of ordinary skill in the art] to combine the relevant teachings of the references." In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

The Office Action, instead of providing objective evidence of a motivation to make such a combination, merely relies on various conclusions of obviousness that simply states the benefits of applicants' invention

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sitnik by gathering user input to determine a reflective profile as taught by Herz in order to maintain an accurate profile for the user

(Office Action, page 7). Such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In addition, relying solely on "applicants' disclosure as a blueprint for piecing together the prior

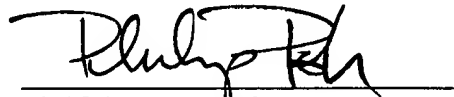
art to defeat patentability" is insufficient as a matter of law. In re Kotzab, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 174 F.3d 994, 999 (Fed. Cir. 1999); see also In re Lee, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) ("The factual inquiry of whether to combine references must be thorough and searching"); MPEP § 2143.

Accordingly, for at least these reasons, applicants respectfully request that the rejection of claims 40, 77, 78, and 79 under 35 U.S.C. § 103(a) be withdrawn.

VI. Conclusion

The foregoing demonstrates that claims 8, 9, 11 and 38-82 are allowable. Reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Philip R. Boh", is written over a horizontal line.

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